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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,158	01/13/2004	William Kress Bodin	AUS920031001US1	3349
34533	7590	08/29/2006	EXAMINER	
INTERNATIONAL CORP (BLF) c/o BIGGERS & OHANIAN, LLP P.O. BOX 1469 AUSTIN, TX 78767-1469			RUTLEDGE, AMELIA L	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/756,158

Applicant(s)

BODIN ET AL.

Examiner

Amelia Rutledge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment, filed 06/15/2006.
2. Claims 1-39 are pending in the case. Claims 1, 14, and 27 are independent claims.
3. Claims 28-39 have been corrected to overcome the previous claim objections.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 1-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

6. **In regard to independent claims 1 and 14, claims 1 and 14 are nonstatutory because they claim descriptive material *per se* not capable of causing functional change in the computer (*Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, hereinafter "Interim Guidelines", p. 50-52).**

7. For example, claim 1 cites: *A method for differential dynamic content delivery, the method comprising: providing a session document for a presentation, wherein the session document includes a session grammar and a session structured document; receiving a prerecorded presentation control instruction; selecting from the session structured document a classified structural element in dependence upon the prerecorded presentation control instruction and in dependence upon user*

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classifications of a user participant in the presentation; and presenting the selected structural element to the user.

As claimed, claim 1 claims descriptive material *per se* (*Interim Guidelines*, p. 50), not recorded on a computer-readable medium, and thereby is not statutory because the claimed invention is not capable of causing functional change in the computer.

Similarly, while claim 14 claims a *system*, the system as claimed also represents a data structure which is not recorded on a computer readable medium and therefore is directed to software *per se*, and for this reason is nonstatutory. As claimed, claims 1 and 14 do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer software and the rest of the computer which permit the software or computer program's functionality to be realized, and would thus be statutory.

In regard to dependent claims 2-13 and 15-26, claims 2-13 and 15-26 are rejected because they add nothing to render the claimed subject matter statutory.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bryan et al. (hereinafter "Bryan"), U.S. Patent No. 6,658,414, issued December 2003, in view of Capra et al. (hereinafter "Capra"), "WebContext: Remote Access to Shared Context", ACM International Conference Proceeding Series, Vol. 15, Proceedings of the 2001 Workshop on Perceptive User Interfaces, 2001, p. 1-9.

Independent claim 1 cites: *A method for differential dynamic content delivery, the method comprising: providing a session document for a presentation, wherein the session document includes a session grammar and a session structured document;* Bryan teaches a voice portal for dynamic content delivery with a session database which maintains the session context and information for the user (Col. 9, l. 9-14). While Bryan does not explicitly teach providing a session document, i.e., a structured document, Capra teaches a method for differential dynamic content delivery, enabling remotely accessible shared context (p. 1, 2, Sect. 3), with a context grammar including session information and grammar, i.e., specifying the time frame in which web pages were browsed (p. 6, Sect. 5.2.3, especially, p. 6, Col. 2, par. 7), contained in an XML document (p. 5-6, Sect. 5.2.2). Therefore, Capra teaches recording session information and a session grammar in a structured document. Further, it was notoriously well known in the art at the time of the invention that session information could be recorded in both structured documents and database entries.

Both Bryan and Capra are analogous art, since both are directed toward searching and presenting information from the web via a voice interface (Capra, p. 1,

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Col. 2, par. 3; Bryan, Abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Capra to Bryan, since Capra teaches creating a structured document containing context grammar to help provide access to the shared context for other applications (Capra, p. 6, Sect. 5.2.3) thereby increasing the portability and accessibility of the shared context (Capra, p. 1, Col. 2, par. 1) and Bryan teaches dynamic voice content delivery and would therefore have the benefit of the portable shared context and user query method taught by Capra.

Claim 1 also cites: *receiving a prerecorded presentation control instruction; selecting from the session structured document a classified structural element in dependence upon the prerecorded presentation control instruction and in dependence upon user classifications of a user participant in the presentation; and presenting the selected structural element to the user.*

Bryan teaches that a user may create a unique, personalized voice portal with keywords, and audio macros, i.e., prerecorded presentation control instructions, which are linked with user classifications, such as data sources of interest, as well as the user identification (Col. 9, l. 22-60). The user uses the prerecorded keywords or macros to access and be presented with presentation elements, such as a stock quote or user specified information (Col. 11, l. 6-54).

Regarding dependent claims 2-3, Bryan teaches that the prerecorded presentation control instruction has an associated time stamp (Col. 11, l. 6-17), and that the voice macros can be recorded repeatedly (Col. 11, l. 48-54).

Regarding dependent claim 4, Bryan teaches that the user defines a key phrase and optional parameters for invoking a presentation action; and parsing the key phrase and parameters against a voice response grammar into a presentation control instruction (Col. 9, l. 40-Col. 10, l. 22).

Regarding dependent claim 5, Bryan teaches that the user can associate different vocabulary words with different data sources, specify keywords for searching the data sources, time intervals of interest, etc. (Col. 9, l. 40-60), and may select structural elements within the portal depending on the presentation action identifier and parameters.

Regarding dependent claim 6, Bryan teaches that a user may create a unique, personalized voice portal with keywords, and audio macros, i.e., prerecorded presentation control instructions, which are linked with user classifications, such as data sources of interest, as well as the user identification (Col. 9, l. 22-60).

Regarding dependent claim 7, Bryan teaches that the user specifies a data communications protocol for the presentation, and the information is translated and transmitted to the user in that protocol (Col. 8, l. 47-65).

Regarding dependent claims 8-10, while Bryan teaches a voice portal for dynamic content delivery with a session database which maintains the session context and information for the user (Col. 9, l. 9-14), Bryan does not explicitly teach providing a session document, i.e., a structured document. However, Capra teaches creating the context document, which also contains session information, by extracting information from the web presentation documents viewed by a user (p. 3-5, Sect. 5.1). Capra

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teaches using a grammar to combine context documents and extract information from them (p. 6, Sect. 5.2.3) to create new output documents, i.e., presentation documents in response to user queries. Capra teaches dynamically filtering the context grammar based on the contents of the files. Bryan teaches creating a voice portal for a user according to the user profile and user classifications (Col. 9, l. 23-60). Bryan teaches searching a structured document to extract user specified information (Col. 8, l. 28-46). Bryan teaches that each user may specify his or her own grammar.

Both Capra and Bryan are analogous art, since both are directed toward searching and presenting information from the web via a voice interface. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Capra to Bryan, since Capra teaches creating a structured document containing context grammar to help provide access to the shared context for other applications thereby increasing the portability and accessibility of the shared context, and Bryan teaches dynamic voice content delivery and would therefore have the benefit of the portable shared context and user query method taught by Capra.

Regarding dependent claim 11, Bryan teaches that a user may create a unique, personalized voice portal with keywords, and audio macros, i.e., prerecorded presentation control instructions, which are linked with user classifications, such as data sources of interest, as well as the user identification (Col. 9, l. 22-60). The user uses the prerecorded keywords or macros to access and be presented with presentation elements, such as a stock quote or user specified information (Col. 11, l. 6-54). The

user creates his or her own presentation grammar, and the voice portal is created from an original template document (Col. 12, l. 9-31).

Regarding dependent claim 12, Bryan teaches that the user may identify presentation attributes such as the order in which searches will be presented, identifying a classification identifier input by the user, and inserting the identifier into the voice portal, i.e., structured document, in association with the search presentation (Col. 12, l. 60-Col. 13, l. 30).

Regarding dependent claim 13, while Bryan teaches that each user defines a unique presentation grammar, Bryan does not explicitly teach the limitations of dependent claim 13, however, Capra teaches creating a grammar for the structured document using the Java Speech Grammar Format version 1.0. Capra teaches identifying the content type of the original document; selecting, in dependence upon the content type, a full presentation grammar from among a multiplicity of full presentation grammars; and filtering the full presentation grammar into a presentation grammar for the structured document in dependence upon the structural elements of the structured document (p. 6, Col. 2 and p. 7 Col. 1). Capra teaches the use of a dynamic context free grammar (CFG).

Both Capra and Bryan are analogous art, since both are directed toward searching and presenting information from the web via a voice interface. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Capra to Bryan, since Capra teaches creating a structured document containing context grammar to help provide access to the shared context for other applications thereby

increasing the portability and accessibility of the shared context, and Bryan teaches dynamic voice content delivery and would therefore have the benefit of the portable shared context and user query method taught by Capra.

Regarding independent claim 14 and dependent claims 15-26, claims 14-26 reflect the system used for implementing the methods claimed in independent claim 1 and dependent claims 2-13, and are rejected along the same rationale.

Regarding independent claim 27 and dependent claims 28-39, claims 27-39 reflect the computer program product comprising a recording medium used for implementing the methods claimed in independent claim 1 and dependent claims 2-13, and are rejected along the same rationale.

Response to Arguments

Applicant's arguments, see Remarks, p. 17-21, filed 06/15/2006, with respect to the rejections of claims 1-26 under the practical application requirements of 35 U.S.C. 101 have been fully considered and are persuasive. The rejections under the practical application requirements of 35 U.S.C. 101 have been withdrawn because applicants persuasively argued that the limitations of the independent claims; *selecting from the session structured document a classified structural element in dependence upon the prerecorded presentation control instruction and in dependence upon user classifications of a user participant in the presentation; and presenting the selected structural element to the user* (Claim 1) claim a practical application.

It is respectfully noted that applicants have not presented arguments or claim amendments regarding the previous rejections of claims 1-26 under 35 U.S.C. 101 for being nonstatutory for claiming descriptive material and/or software *per se*, not recorded on a computer readable medium, therefore those rejections must be maintained. As claimed, claim 1 claims descriptive material *per se* (*Interim Guidelines*, p. 50), not recorded on a computer-readable medium, and thereby is not statutory because the claimed invention is not capable of causing functional change in the computer. Similarly, while claim 14 claims a *system*, the system as claimed also represents a data structure which is not recorded on a computer readable medium and therefore is directed to software *per se*, and for this reason is nonstatutory. As claimed, claims 1 and 14 do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer software and the rest of the computer which permit the software or computer program's functionality to be realized, and would thus be statutory.

Applicant's arguments filed 06/15/2006 regarding the claim rejections of claims 1-39 under 35 U.S.C. 103 over Bryan in view of Capra have been fully considered but they are not persuasive. While applicants argue that the combination of Bryan and Capra does not disclose the session document claimed in claim 1, for example, (Remarks, p. 22-27), in response to applicant's argument that the references fail to

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show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Remarks, p. 24-27, describing a session document derived from a presentation document, having filtered presentation content, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants argue that Bryan does not teach a session document but teaches a session database (Remarks, p. 22-25). It is respectfully noted that Bryan was not relied upon in the rejection to disclose the session document. However, while Bryan does not explicitly teach providing a session document, i.e., a structured document, Capra teaches a method for differential dynamic content delivery, enabling remotely accessible shared context (p. 1, 2, Sect. 3), with a context grammar including session information and grammar, i.e., specifying the time frame in which web pages were browsed (p. 6, Sect. 5.2.3, especially, p. 6, Col. 2, par. 7), contained in an XML document (p. 5-6, Sect. 5.2.2). Therefore, Capra explicitly teaches recording session information and a session grammar in a structured document.

Applicants argue that Bryan in view of Capra does not disclose the limitations of the independent claims *receiving a prerecorded presentation control instruction; selecting from the session structured document a classified structural element in dependence upon the prerecorded presentation control instruction and in dependence upon user classifications of a user participant in the presentation; and presenting the selected structural element to the user* (Claim 1) (Remarks, p. 28-34). The examiner

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maintains that Bryan does teach the cited claim limitations since Bryan teaches that a user may create a unique, personalized voice portal with keywords, and audio macros, i.e., prerecorded presentation control instructions, which are linked with user classifications, such as data sources of interest, as well as the user identification (Col. 9, l. 22-60). The user uses the prerecorded keywords or macros to access and be presented with presentation elements, such as a stock quote or user specified information (Col. 11, l. 6-54). Therefore Bryan does explicitly teach the cited limitations.

The claim rejections of claims 1, 14, and 27 and their dependent claims are maintained for the reasons of record, since the combination of Bryan and Capra does disclose the elements of both the independent and dependent claims (Remarks, p. 34-35).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Bryan and Capra are analogous art, since both are directed toward searching and presenting information from the web via a voice interface (Capra, p. 1, Col. 2, par. 3; Bryan, Abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Capra to Bryan, since Capra teaches creating a structured document

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containing context grammar to help provide access to the shared context for other applications (Capra, p. 6, Sect. 5.2.3) thereby increasing the portability and accessibility of the shared context (Capra, p. 1, Col. 2, par. 1) and Bryan teaches dynamic voice content delivery and would therefore have the benefit of the portable shared context and user query method taught by Capra. Therefore, the motivation to combine the references may be found in the cited portions of Capra.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia Rutledge whose telephone number is 571-272-7508. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR


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